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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,742	06/21/2001	Emerson Keith Colyer	IN-5486	6026
26922	7590	12/30/2003	EXAMINER	
BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442			ZALUKAEVA, TATYANA	
		ART UNIT	PAPER NUMBER	
		1713		

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/886,742	COLYER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Tatyana Zalukaeva	1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) 24-32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 18-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 18-32 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

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## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/16/2003 has been entered.

### ***Election/Restrictions***

2. Applicant's election without traverse of 18-23 and cancellation of claims 11-7 in Paper No. 15 is acknowledged.

#### **Claims 18-32 are currently pending.**

Applicants submitted that claims 24-32 have been amended to depend on claim 18, however, these two groups of claims are still related as a product and a process for its use, and are restrictable.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used in a different process, such as, for example, the composition is dissolved in appropriate solvent and sprayed onto substrate along

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with crosslinking reagent and cured without drying. Since the election was made by Applicants of claims 18-23, these claims are examined on the merits. Claims 24-32 are currently withdrawn from consideration. .

Applicants are advised that if claims drawn to a composition are found allowable, then claims directed to a method of using such composition will be rejoined, as per In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and In re Brouwer, 7 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996).

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 18, 20-23 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jouck et al (U.S. 5,322,715).

Jouck discloses base coat composition, which contains an emulsion polymer as a film forming material and a plurality of pigments inorganic colored pigments such as, for example, titanium dioxide, iron oxide, carbon black etc., organic colored pigments as well as the customary metal pigments (for example, commercial aluminum bronzes, stainless steel bronzes . . . ) and non-metallic effect pigments (for example nacreous luster pigments and interference pigments). The basecoat coating compositions preferably contain metal pigments and/or effect pigments. The degree of pigmentation lies within the customary range, preferably 0 to 10% by weight, based on the total

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weight of the basecoat coating composition (column 12, lines 34-46). The polymer of Jouck is prepared by two-stage polymerization. In the first stage 10 to 90, preferably 35 to 65 parts by weight of an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers are emulsion polymerized (col. 5, lines 27-30). The first stage a1) 100 to 60, preferably 99.5 to 75% by weight of a cycloaliphatic or aliphatic ester of methacrylic acid or acrylic acid or a mixture of such esters and a2) 0 to 40, preferably 0.5 to 25% by weight of a monomer which is copolymerizable with (a1) or a mixture of such monomers (col. 5, lines 6-12).

Examples of monomers which can be used in the second stage, are as follows:

vinylaromatic hydrocarbons esters of the acrylic acid or methacrylic acid, in particular aliphatic and **cycloaliphatic acrylates or methacrylates** having up to 20 carbon atoms in the alcohol radical, such as, for example, methyl, ethyl, propyl, butyl, hexyl, ethylhexyl, stearyl, lauryl and **cyclohexyl acrylate** or 2-hydroxyethyl acrylate, 2-hydroxypropyl acrylate, 3-hydroxypropyl acrylate, 2-hydroxypropyl methacrylate, 3-hydroxypropyl methacrylate, etc. A mixture consisting of  
(b1) 47 to 99, preferably 75 to 90% by weight of a cycloaliphatic ester of methacrylic acid or acrylic acid  
(b2) 1 to 20, by weight of a monomer which is copolymerizable with (b1), (b3) and (b4) and carries at least one hydroxyl group or a mixture of such monomers  
(b3) 0 to 8, preferably 2 to 6% by weight of a monomer which is copolymerizable with (b1), (b2) and

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((b4) 0 to 25, preferably 2 to 15% by weight of a further monomer which is copolymerizable with (b1), (b2) and (b3) (col. 6, lines 1-20 and 26-46)

The emulsion polymer of Jouck has Mn higher than 200,000 (col. 6, lines 60-62) and hydroxyl number is 2-100 mg KOH /g (col. 6, lines 64, 65).

Further crosslinked polymeric microparticles can be added and/or customary inorganic or organic additives discussed in details in col. 12, lines 46-66.

Therefore the limitations of the instant claims 18, 20-23 are met by the disclosure of Jouck.

In the alternative this rejection is made in the sense of 35 USC 103(a), stating that the refinish property of the basecoat composition of Jouck will be either inherent or obvious to a person skilled in the art since the composition of Jouck is essentially the same the instantly claimed composition. The burden to show that this, in fact, is not the case is shifted to applicants as per *In re Fitzgerald* (205 USPQ 594). (CAFC) . With regard to the limitation that "...the color components (pigments) are so related that a composition of any desired color can be produced", it is noted that such inherently flows from the use of recited pigments, because the use of pigment per se is solely for the purpose of obtaining color.

***Terminal Disclaimer***

5. The terminal disclaimer filed on 10/23/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,518,338 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

6. Applicant's arguments filed March 6, 2003 have been fully considered but they are not persuasive.

**Relative to Jouck et al.:**

- a) Jouck does not disclose an intermix system having components (a) and (b). (claim 18)  
Specific places in Specification are shown above where such components are disclosed.
- b) Jouck does not disclose a crosslinker reactive hydroxyfunctional acrylic polymer (claim 20)

In response to this, Applicants attention is drawn to col.17, lines 44-54, wherein the basecoat coating compositions are sprayed by well-known methods onto a phosphated steel panel (Bonder 132) coated by a commercial electrocoating process and a commercial conventional (i.e. solvent-borne or water-borne) filler, after a flash-off period of 30 minutes coated by a commercial conventional 2-component clear varnish based on hydroxyl-containing acrylate copolymer and an isocyanate crosslinking agent and dried for 30 minutes.

Carbon black pigment is shown in col.5, lines 27-30

With regard to Applicants argument on inherency of some characteristics, the burden was shifted to Applicants to show that such characteristics are not inherent, if so, as per In re Fitzgerald, as set forth in the previous Office Action on the merits.

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The rejection can also be regarded in the sense of In re Spada, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), stating that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art. In the other words, composition and its properties are inseparable, and identical compositions cannot have mutually exclusive properties. With regard to Applicants arguments, that Jouck does not anticipate or suggest the use of intermix, it is noted that the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970)., it is further noted that “[A]n Examiner has the duty to police the claim language by giving it the broadest possible interpretation”, Springs Window Fashions LP v. Novo Industries L.P., 65, USPQ 2d 1826, 1830 (Fed. Cir. 2003). Furthermore, [A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art...”. In re Morris, 44 USPQ 2d 1023,1027 (Fed. Cir. 1997). In light of the above the “intermix” of the instant claims is read according to the meaning provided by the dictionary” mixing together”. All compositions of Jouck are made by mixing components together, see, for example, col.12, lines 15-22.

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**Relative to Benefiel:** Applicants arguments are moot since the reference to Benefiel is withdrawn from the scope of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 305-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Tatyana Zalukaeva, Ph.D.  
Primary Examiner  
Art Unit 1713

December 19, 2003